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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,394	01/26/2001	Bradley M. Wilkinson	P-3914F1P1P2P1RI	6920

26253 7590 02/17/2004

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EXAMINER
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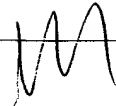
THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/771,394	<b>Applicant(s)</b> WILKINSON ET AL. 	
	<b>Examiner</b> Michael Thaler	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-38 and 40-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-38, 41-53, 67-74 and 76-78 is/are allowed.
- 6) ☒ Claim(s) 40, 54-66, 75 and 79-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Contrary to the amendments to the drawings (page 27 of the response filed Oct. 27, 2004), figures 36c and 36d have not been amended by replacing reference characters "a" and "b" in figures. Further, there is no figure 36d. Further, the reference characters "a" and "b" in figures 35c and 35d have not been replaced.

Contrary to applicant's remarks on page 29 of the response filed Dec. 8, 2003, claims 59 and 75 have not been canceled.

Claims 40, 59 and 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 40 depends from canceled claim 39. Claims 59 and 75 are confusing and inaccurate since top cut away portion 440 does not extend between two end portions having a raised upper surface.

Claims 59 and 75 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original disclosure for the subject matter in these claims for the reasons set forth in the paragraph above.

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Claims 54, 57-59, 61-66 and 79-87 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Werner (5,292,329). Werner discloses handle 44 defined by a pair of semicircular sidewalls, groove 52, blade 46, shield 42 slidably mounted to the handle along the distal portion of the handle so as to be movable between a distal position shielding the blade (figures 1 and 3) and a proximal position exposing the blade for use without enclosing the proximal portion of the handle (figures 2 and 4) and latch 64 having an inward projection 66 disposed in groove 52. Alternatively, it would have been obvious that member 44 is a handle since it may be grasped by the hand. As to claim 58, Werner discloses top cut away portion (at 54). As to claim 62, Werner discloses handle 44 comprising proximal hand gripping portion (the proximal portion of member 44), intermediate shank 98, tang (one of the two diametrically opposed arc shaped portions extending from the distal end of shank 98) which is inherently capable of being directly engaged to a scalpel blade, as broadly claimed (since it may simply be pressed against a scalpel blade to engage or touch it) and means 102 for releasably connecting the handle 44 to a cartridge 88 (col. 5, lines 67-68). Alternatively, it would have been obvious that member 44 is a handle since it may be grasped by the hand. As

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to claim 63, Werner discloses a downwardly extending projection. As to claims 64 and 65, Werner discloses groove 52 with upturned portion 54. As to claim 66, the Werner tang defines a recess disposed therein (within the arc shape of the tang). As to claim 79, the removal of handle 44 from cartridge 88 would inherently prevent the movement of shield 42 relative to the blade since the blade would be entirely within the shield and, with no handle present, there would be nothing to hold the blade stationary as the shield is moved (in a manner similar to that described in col. 7, lines 48-52 of the patent for which the reissue is desired). As to claim 83, the cartridge 88 is lockingly engaged to the handle 44 (at 102). When the shield is in the distal position, the cartridge 88 may be inherently unlocked from the handle 44 by removing pin 102.

Claims 55, 56 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner (5,292,329). As to claim 55, Werner fails to disclose an upturned distal end at the distal end of the groove 52 and the latch 64 being cantilevered. However, it is well known in this art to provide a locks for a surgical scalpel shield so that it may be positively locked both in the retracted and the forward positions. It would have been obvious to provide an upturned end (similar to 54) at the distal end of the groove 52 of Werner so that it too would have this

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advantage. As to claim 60, Werner fails to disclose an inwardly projecting rail. However, it is well known in this art to provide an inwardly projecting rail on a scalpel shield so that it slides smoothly on the handle. It would have been obvious to provide an inwardly projecting rail on the Werner device so that it too would have this advantage. The above well known in the art statements are taken to be admitted prior art because applicant failed to traverse the examiner's assertions (M.P.E.P. 2144.03).

Claims 1-38, 41-53, 67-74 and 76-78 are allowed.

Claims 40 and 75 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Applicant's arguments filed Dec. 8, 2003 have been fully considered but they are not persuasive for the reasons set forth above. Further, the allegation that the Werner sheath is not slidably mounted to the distal portion of the handle is not well taken. Shield 42 of Werner is slidably mounted to handle 44 along the distal portion of handle 44 as seen in figures 1-4. Further, the shield 42 is slidably mounted to the handle along the distal portion of the handle so as to be movable to a proximal position exposing the blade for use without enclosing the proximal portion of the handle since the proximal portion of

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handle 44 is not covered by the shield 42 as seen in figures 2 and 4. Although the shield 42 may serve as a handle, member 44 may also be considered a handle since it is grasped by the hand.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the

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organization where this application or proceeding is assigned is  
(703)872-9306.

mht  
12/13/04

A handwritten signature in black ink, appearing to read "Michael Thaler", written in a cursive style.

MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731